Customer No. 3460 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	VOOIS *et al.*	Examiner:	Shingles, Kristie D.
Serial No.:	09/597,704	Group Art Unit:	2141
Filed:	June 16, 2000	Docket No.:	8X8S.249PA
Title:	COMMUNICATIONS CONTROLLER AND METHOD THEREFOR		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No. 40581

Dear Sir:

This Appeal Brief is submitted pursuant to 37 C.F.R. §41.37, in support of the Notice of Appeal filed November 5, 2007 and in response to the rejections of claims 1-22 as set forth in the Final Office Action dated August 3, 2007, and in further response to the Advisory Action dated October 26, 2007.

Please charge Deposit Account No. 50-0996 $510.00 (8X8S.249PA) the LARGE-ENTITY fee for filing this brief in support of an appeal as set forth in 37 C.F.R. §1.17(c). If necessary, authority is given to charge/credit Deposit Account 50-0996 additional fees/overages in support of this filing.

A Petition for One-Month Extension of Time, wherein all requisite fees are authorized, accompanies this paper.

I. Real Party In Interest

The real party in interest is 8x8, Inc., having a principal place of business at 3151 Jay Street, Santa Clara, California 95054-3308. The above-referenced patent application is assigned to 8x8, Inc.

II. Related Appeals and Interferences

While Appellant is aware of other pending applications owned by the above-identified Assignee, Appellant is unaware of any related appeals, interferences or judicial proceedings that would have a bearing on the Board's decision in the instant appeal.

III. Status of Claims

Claims 1-22 stand rejected and are presented for appeal. A complete listing of the claims under appeal is provided in an Appendix to this Brief.

IV. Status of Amendments

No amendments have been filed subsequent to the Final Office Action dated August 3, 2007.

V. Summary of Claimed Subject Matter

Commensurate with independent claim 1, an example embodiment of the present invention is directed to a user-programmable communications arrangement including a computer having a display, a user interface and a programmable controller (*e.g.*, 412 in FIG. 4 and at pages 11:21-12:13). The user interface and the programmable controller provide user-selected IP telephony configuration information to a control center (*e.g.*, 405 of FIG. 4 and at page 12:8) communicatively coupled to a plurality of IP telephony devices (*e.g.*, 414, 415, 416, 431 and 432 of FIG. 4 and at page 12:5). The user interface and programmable controller further display a control interface for at least one of: user control of an IP telephony device, office telephone administration control of a plurality of telephony devices, and system administrator control of telephony system configuration. The IP telephony

configuration information is selected to control communications between, and to programmably configure, the control center and the plurality of IP telephony devices.

Commensurate with independent claim 15, an example embodiment of the present invention is directed to a user-programmable communications arrangement including a user-interface device having a display (*e.g.*, 412 in FIG. 4 and at pages 11:21-12:13), and a programmable CPU (*e.g.*, 405 at 12:8). The user interface device provides IP telephony communications configuration information to a user via the display, and communicates IP telephony communications configuration selections from the user to a CPU. The programmable CPU is communicatively coupled to the user interface device and has an OOP interface coupled to an IP telephony communications link (*e.g.*, 402 at 12:3). A microprocessor (*e.g.*, with the programmable CPU) receives the IP telephony communications configuration selections from the user-interface device and, in response to the received selections, controls selected functions of selected IP telephony devices of an IP telephony communications system via the IP telephony communications link.

Commensurate with independent claim 20, an example embodiment of the present invention is directed to a user-programmable communications control system for controlling a communications network using OOP code (*e.g.*, system 400 of FIG. 4 at 11:21-13:18). The control system includes a plurality of telephony devices (*e.g.*, 414, 415, 416, 431 and 432 at 12:5), a computer station (*e.g.*, 412) and a programmable communications server (*e.g.*, 405). The telephony devices are coupled to an IP communications link (*e.g.*, 402) and communicate IP telephony data. The computer station includes an OOP interface, displays communications information including telephony communications information, and provides communications control selections including telephony control selections to the IP communications link. The programmable communications server has an IP telephony switch and an OOP interface coupled to the IP communications link, and receives the communications control selections. The programmable communications server controls the communications network, including the plurality of telephony devices, in response to the selections received through the OOP interface.

As required by 37 C.F.R. § 41.37(c)(1)(v), a concise explanation of the subject matter defined in the independent claims involved in the appeal is provided herein. Appellant notes

that representative subject matter is identified for these claims; however, the abundance of supporting subject matter in the application prohibits identifying all textual and diagrammatic references to each claimed recitation. Appellant thus submits that other application subject matter, which supports the claims but is not specifically identified above, may be found elsewhere in the application. Appellant further notes that this summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and their legal equivalents for a complete statement of the invention.

VI. Grounds of Rejection to be Reviewed Upon Appeal

1. Claims 1-22 stand rejected under 35 U.S.C. § 102(e) over Brophy *et al.* (U.S. 6,782,412).
2. Claims 1-22 stand rejected under 35 U.S.C. § 112(2) as being indefinite.

VII. Arguments

Each of the rejections should be reversed because each relies upon a misapplication the law and/or the M.P.E.P. Specifically, the Section 102(e) rejection must be reversed because the record has established that the cited Brophy reference is not prior art, by way of a Section 1.131 Declaration that the Examiner has improperly ignored. In an effort to avoid Appeal, Appellant contacted the Examiner to discuss the Section 1.131 Declaration, but was unable to obtain a definitive response. The Section 112(2) rejections must also be reversed because the Examiner has improperly concluded that the terms "adapted to" are non-limiting in scope, without providing any rationale in support of this conclusion and in contrast to the law, M.P.E.P. and well-established use of these terms. The following more particularly addresses each of these above issues.

A. The Section 102(e) rejections of claims 1-22 over Brophy must be reversed because the Examiner has improperly ignored the Section 1.131 Declaration, which establishes that the Brophy reference is not prior art.

The Section 102(e) rejection turns upon the acceptance of the Section 1.131 Declaration (attached hereto) because this Declaration establishes that the Brophy reference is not prior art, and further establishes a reduction to practice that is prior to the Brophy reference, thus making the Section 102(e) rejection and the Examiner's asserted lack of diligence both moot. In short, the Examiner has indicated that Appellant's Section 1.131 Declaration is ineffective simply because one of the documents filed with the Declaration is dated later than the indicated reduction to practice, despite the fact that other papers in the Exhibits and the supporting text in the Declaration establish an earlier reduction to practice. Appellant submits that the later-dated paper relied upon by the Examiner (in asserting the Declaration as ineffective) simply corroborates the statements in the Declaration and the earlier papers in the Exhibits (*e.g.*, Exhibit B), as well as the earlier reduction to practice, and does not have any effect upon the evidenced reduction to practice.

In consideration of the above, the Examiner's position regarding the Declaration is contrary to Section 1.131 and relevant law. Specifically, while Exhibit A includes a date that is after the filing date of the Brophy reference, the Examiner has not cited any law that indicates that an Exhibit filed with a Declaration cannot include such a later date, and/or that such a Declaration is ineffective where other Exhibits and supporting Declaration establish the indicated reduction to practice. Appellant has reviewed Section 1.131 and related law and cannot ascertain any indication that the Exhibits as filed are insufficient to support the indicated reduction to practice.

The Examiner has thus ignored dates the Exhibit papers filed with the Declaration and as supported in the text of the Declaration, and has instead relied upon a single date in the first exhibit that is not relevant to the indicated reduction to practice. Specifically, Exhibit B includes evidence that establishes a reduction to practice prior to the August 24, 1999 date of the Brophy reference, and Exhibit A includes a later-dated document that describes previous results regarding the claimed invention and its reduction to practice (as may be relevant to the evidence

in Exhibit B). In this regard, the description in Exhibit A evidences an earlier reduction to practice, regardless of the date of the Exhibit itself. In this regard, the Examiner's position that the declaration is insufficient is unfounded and contrary to 37 C.F.R. §1.131.

Regarding the Examiner's mention of diligence, Appellant submits that evidence of diligence is not relevant where the invention was reduced to practice prior to the date of the cited reference. For example, reduction to practice (*i.e.*, constructive and actual) is evidenced in advance of the Brophy's effective date by the Declaration and its exhibits. Regarding the independent claims (*i.e.,* claims 1, 15 and 20), page 10 of Exhibit B shows an IntraSwitch PBX (*i.e.,* a control center) that is communicatively coupled to a PC, an IP phone, a video phone, etc. (*i.e.,* a plurality of IP telephony devices). The PC has a display and a user interface that allows a user to configure the IntraSwitch PBX and the other IP telephony devices. Per pages 17 and 18 of Exhibit B, the system provides for user and administration configuration (*i.e.,* control and configuration of the control center and the plurality of IP telephony devices), and further provides various types of user control over telephony communications. Moreover, as discussed at page 14 of Exhibit B, IntraSwitch is implemented using OOP, including Java applets. Per the discussion in both Exhibit A and Exhibit B, this reduction to practice was conceptual and actual, with reference to both testing and implementation (*see, e.g.*, the pages labeled "17" and "18" in Exhibit B, respectively describing lab testing onsite testing). Therefore, reduction to practice prior to August 24, 1999, has been demonstrated by the evidence of record.

In view of the above, the declaration 37 C.F.R. § 1.131 filed on May 24, 2007 is proper and overcomes the Section 102(e) rejection of claims 1-22. Therefore, the Brophy reference is not prior art under Section 102(e) and the Section 102(e) rejection of claims 1-22 must be reversed.

B. The Section 112(2) rejections of claims 1-22 must be reversed because the indicated terms "adapted to" as used in the instant application are appropriate under relevant law and widely-accepted.

The Section 112(2) rejection of claims 1-22 based upon the use of the term "adapted to" must be reversed because the Examiner has failed to establish that the term results in claims that are non-limiting in scope. Despite Appellant's requests in different responses, the Examiner has continued to provide no rationale whatsoever as to why the clause "adapted to" is non-limiting in this instance, in a manner consistent with relevant law and the M.P.E.P. Rather than provide any rationale, the rejection vaguely asserts that the phrase "adapted to" is "non-limiting in scope" with no explanation as to why these terms are non-limiting in this instance. The rejection itself states that "[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case" (citing Hoffer v. Microsoft Corp., 405 F.3d 1326, 1329 (Fed. Cir. 2005), yet fails to discuss any facts in the instant case. As Appellant has indicated previously, the term "adapted to" has come to be a commonly used term in claiming an invention and is clear (*i.e.*, to one of skill in the art) as used in the instant application. A brief review of the U.S. Patent Office's own database indicates that the term "adapted" has been used in the claims of over 100,000 issued patents in recent years.

Moreover, the terms "adapted to" as used in the claims in connection with other claim limitations clearly characterize the claim limitations. For instance, referring to claim 1, a user interface and programmable controller are adapted to carry out the claim limitations directed to providing user-selected IP telephony configuration information and displaying a control interface, where the IP telephony configuration information controls communications between and programmably configures a control center and a plurality of IP telephony devices. Regarding claim 15, a user-interface device is adapted to provide IP telephony communications configuration information to a user and to communicate IP telephony communications configuration selections from the user to a CPU. A microprocessor (*e.g.*, CPU) is adapted to receive the IP telephony communications configuration selections from the user-interface device and, in response to the received selections, to control selected functions of selected IP telephony devices of an IP telephony communications. Regarding

claim 20, a plurality of telephony devices are adapted to communicate IP telephony data, a computer station is adapted to display communications information including telephony communications information and to provide communications control selections to an IP communications link, and a programmable communications server is adapted to receive the communications control selections and to control the communications network. Appellant cannot ascertain any interpretation of the limitations "adapted to" in each of these independent claims as "non-limiting in scope," either on their face or in view of the widely-accepted use of the terms "adapted to."

In view of the foregoing, Applicant contends that the Section 112(2) rejection is without basis and contrary to relevant law and the M.P.E.P., and must therefore be reversed.

VIII. Conclusion

In view of the above, Appellant submits that the rejections of claims 1-22 are improper. Appellant therefore requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

Authority to charge the undersigned's deposit account was provided on the first page of this brief.

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Respectfully Submitted,

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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
(S/N 09/597,704)

1. A user-programmable communications arrangement including a computer having a display, the arrangement comprising: a user interface; and a programmable controller, the user interface and the programmable controller being adapted to:

provide user-selected IP telephony configuration information to a control center communicatively coupled to a plurality of IP telephony devices;

display a control interface for at least one of: user control of an IP telephony device, office telephone administration control of a plurality of telephony devices, and system administrator control of telephony system configuration; and

the IP telephony configuration information being selected to control communications between, and to programmably configure, the control center and the plurality of IP telephony devices.

2. The user-programmable communications arrangement of claim 1, wherein the computer is adapted to announce an incoming call via the display, the call announce being effected without overtaking currently-running applications.

3. The user-programmable communications arrangement of claim 2, wherein the call announce is effected using a locally-installed OOP applet that runs in the background of the computer.

4. The user-programmable communications arrangement of claim 2, wherein the call announce displays user control options including at least one of: caller ID, speaker phone, answer, forward to voicemail, hold, and call termination.

5. The user-programmable communications arrangement of claim 1, wherein the user interface includes a graphic user interface (GUI).

6. The user-programmable communications arrangement of claim 1, wherein the computer includes one of the plurality of IP telephony devices.

7. The user-programmable communications arrangement of claim 1, wherein the controller is adapted to access personal contact information.

8. The user-programmable communications arrangement of claim 7, wherein the personal contact information is arranged in a searchable database accessible by the controller, the database being accessible via user-defined shuffle-search statements.

9. The user-programmable communications arrangement of claim 1, wherein the controller is adapted to provide a control interface for system administration control of an IP telephony network, the interface being adapted to provide at least one of: IP telephony system configuration and system status information.

10. The user-programmable communications arrangement of claim 9, wherein the IP telephony system status information includes at least one of: IP address assignment information for telephony devices, user-access security control level settings, current telephony device hardware settings, display settings for the controller, and telephony device location information.

11. The user-programmable communications arrangement of claim 9, wherein the control interface is adapted to configure the IP telephony system to control at least one of: telephony device address assignment, user-access permissions, system report generation, display settings for the controller, voice mail parameters, IP telephony device hardware configuration, system backups, call routing protocol, call accounting, email configuration settings and call logging.

12. The user-programmable communications arrangement of claim 1, wherein the computer is adapted to use OOP for providing the user-selected IP telephony configuration information to the control center.

13. The user-programmable communications arrangement of claim 1, wherein user control of an IP telephony device includes active call control and call receive settings including at least one of: speaker phone activation, call answer, call forward to voicemail, call forward to another number or IP telephony address, call hold, call termination, display of caller ID, speed dial, call transfer, redial, voicemail forwarding, voicemail messaging, multi-party calling call muting, video control, and remote access control for remote access to telephony services.

14. The user-programmable communications arrangement of claim 1, wherein each of the plurality of IP telephony devices includes a CPU, and wherein the user interface and controller are further adapted to:

provide user-selected email configuration information to a control center communicatively coupled to each CPU;

display a control interface for at least one of: user control of email configuration, office administration control of the plurality of CPUs, and system administrator control of email system configuration; and

the email configuration information being selected to control communications between, and to programmably configure, the control center and the plurality of CPUs.

15. A user-programmable communications arrangement comprising:

a user-interface device having a display, the device being adapted to provide IP telephony communications configuration information to a user via the display and to communicate IP telephony communications configuration selections from the user to a CPU; and

a programmable CPU communicatively coupled to the user interface device and having an OOP interface coupled to an IP telephony communications link, the

microprocessor being adapted to receive the IP telephony communications configuration selections from the user-interface device and, in response to the received selections, control selected functions of selected IP telephony devices of an IP telephony communications system via the IP telephony communications link.

16. The user-programmable communications controller of claim 15, wherein the CPU is adapted to control the scope of IP telephony communications configuration selections that can be made by a particular user.

17. The user-programmable communications controller of claim 15, wherein the IP telephony system includes a memory storage device having user-access configuration data, wherein the CPU receives the configuration data for controlling the scope of configuration selections that can be made by a particular user.

18. The user-programmable communications controller of claim 17, wherein the memory storage device is adapted to send display information to the user-interface device using OOP, the display information including available IP telephony communications selections.

19. The user-programmable communications controller of claim 15, wherein the user-interface device communicates the configuration selections using OOP.

20. A user-programmable communications control system for controlling a communications network using OOP code, the control system comprising:

a plurality of telephony devices coupled to an IP communications link and adapted to communicate IP telephony data;

a computer station having an OOP interface, the station being adapted to display communications information including telephony communications information and to provide communications control selections including telephony control selections to the IP communications link; and

a programmable communications server having an IP telephony switch and an OOP interface coupled to the IP communications link and adapted to receive the communications control selections, the programmable communications server being adapted to control the communications network, including the plurality of telephony devices, responsive to the selections received through the OOP interface.

21. The user-programmable communications control system of claim 20, wherein the scope of communications control selections that can be made at the computer station is controlled by the programmable communications server based on a predefined user-access permission level.

22. The user-programmable communications control system of claim 20, further comprising a plurality of the computer stations, wherein programmable communications server is adapted to receive communications control selections from each of the plurality of computer stations.

APPENDIX OF EVIDENCE

Appellant is aware of evidence of record in this application pursuant to 37 C.F.R. § 1.131, the Inventor's § 1.131 Declaration and Exhibits A-B (9 pgs.) filed on May 24, 2007. A true copy of this evidence is reattached to this Appeal Brief.

Appellant is unaware of any other evidence submitted in this application pursuant to 37 C.F.R. §§ 1.130 and 1.132.

APPENDIX OF RELATED PROCEEDINGS

As stated in Section II above, Appellant is unaware of any related appeals, interferences or judicial proceedings.